3721

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of FREDRIC GOLDSTEIN

Docket No.: N898 (amended)

Serial No.: 09/340,303

Examiner: KIM, EUGENE LEE

Filing Date: 06/28/99

Art Unit: 3721

Title: RIBBON CURLING AND SHREDDING DEVICE

Commissioner for Patents
Washington, DC 20231

INFORMATION DISCLOSURE STATEMENT

The following background art is provided under 37 C.F.R. 1.97 and copies are included in compliance with 37 CFR 1.98. A list of the articles being submitted herewith is set forth on the enclosed Form PTO-1449.

[ ] 37 C.F.R 1.97(b) - Within three months of the filing date of a national application, within three months of the date of entry of the national stage as set forth in 37 C.F.R. 1.491 n an international application, or before the mailing date of a first Office Action on the merits, whichever event occurs last. No certification, petition or fees required.

[x] Best available copies of information listed are enclosed.

[ ] A discussion of this material can be found on page(s) of the specification.

REMARKS

Applicant discloses the following patents recently brought to his attention during the litigation of the on-going lawsuit Group One Ltd v Hallmark Cards, Inc (In The United States District Court For The Western District Of Missouri Western Division/ Case No. 97-1224-CV-W-1) which has previously been brought to the PTO's attention as it relates to two parent patents (5,518,492 and 5,711,752), of the instant application (see Appendix A). Although these references are disclosed merely because the defendant in the above case cited them as an affirmative defense as part of a litigation tactic concerning the patents in suit, Applicant nevertheless submits these patents in this IDS pursuant to his duty of candor with regards to prior art disclosures.

Applicant however is of the opinion that the prior art cited below does not affect patentability for this instant application and for the general reason that these references, alone or in combination, do not disclose or suggest the subject matter claimed in this application, and for the foregoing specific reasons: the claims in the instant application are different than those of the

patents in suit; the patents are generally not in the same field of art, not the same US Class. There is no motivation for a skilled man in the art to look to these fields and find these patents and there is no motivation for combining these patents (since anticipation is not an issue, combining the patents is required under obviousness); the prior art cited is not as material as that already cited nor even if as material would not be an obstacle to patentability; several of the patents are over one hundred years old; the prior art inventions address different fields and a different problems than that of the instant invention.

Applicant cites each patent with comments on each:

1. The 2,935,179 Brautgam patent

This patent is geared towards feeding a multifilament strand. No curling action is involved. The drive means is a single wheel. The inventor claims that various forces will keep the strand adhered to the rotating wheel but states these forces "are not understood" and uses the word "apparently" on several occasions.

Several points should be noted:

One, as a drive means for drawing ribbon over a curling blade it is unworkable.

a. The high speed taught (on the order of 15,000 ft/min) is impossible for curling ribbon. It is this high speed which is claimed to cause the filament strand to adhere to the singular pulling wheel 16. Where the drive means principle is different from that in the instant application, the means to strip a strand off that drive means is necessarily immaterial since the forces to be counteracted are different.

b. The singular pulling wheel is taught to be polished to as smooth a surface as possible, which is counterintuitive for a wheel which must exert tractive force to grip the ribbon in order to overcome the drag over the curling means.

c. Moreover a liquid is taught to be applied to the wheel to create a surface tension which is claimed to cause the strand to adhere to the singular wheel.

d. Any tractive force required to pull a strand of ribbon for curling is non-existent in this configuration and for such material; it seems to be inadequate for the simple feeding of ribbon, much less for the traction required to pull a ribbon over a curling blade.

e. The strand would never even reach the disengaging means as it would fly off well prior to that.

Two, the strand is straight and thus would most likely notcircle past the vertical point (i.e. 3 o'clock on the wheel) to the point of jamming the wheel, which is around 6 o'clock. The instant

application deals with curled ribbon which presents other problems.

Three, the separation structures in this patent (19-22) do not physically come into contact with the strand. It is solely the use of aerodynamics which creates an air flow that allegedly guides the strand off. The structure shown is too small to effective act as a stripping means as the curled nature of the ribbon would allow it to pass over the blade and adhere to the wheel nevertheless.

Four, since this patent does not have every element of the instant application, it cannot constitute anticipation. The defendant in the aforementioned litigation has not claimed anticipation based upon this or any herein cited reference.

Five, as far as obviousness, this patent appears not to be in the same field of art as the Goldstein invention. The US Class of this patent is 226/188; 65/500; 65/533; 226/5; 226/196.1; 242/157R; 242/615.11. The Goldstein patents are 493/459, 493/460; 493/461. That means a skilled man in the art would not be expected to find and combine this patent with any of the other Goldstein curling inventions as there appears to be no motive to combine nor for a skilled man in the art to look in both fields (the fact that the USPTO, the PCT, and the European Patent Office all did not look in that field to find this patent is evidence enough). There are literally thousands of patents which involve web material which is fed (such as printing presses, manufacture of sheets of a wide range of material, etc. Nearly all have some air or fence or some structure to direct the movement of the sheet. They are no more relevant than this patent as they address a different problem and do not suggest the solution to the problem addressed in the instant invention.

Applicant notes that this patent was not referenced in the previously earliest cited prior art, the Cerone patent. It is telling that none of the patents disclosed herein include each other in their respective list of referenced patents.

2. 123,491 Little

This patent is very old, from 1872. It is quite similar to the above Œ179 patent and one could argue that it would have been cited as a prior art reference in that patent. It was not. It addresses much the exact same problem. Again here there is no curling involved, the material is not curled but straight. Anticipation is out. There is no motivation for combining this with any curling invention nor to look in this field of art. It additionally would not function to prevent curled ribbon from jamming the drive means.

3. 1,595,478 Fullerton

There is no relevance in this patent with regards to the instant invention. It deals with the transport of newspapers which are not a continuous or lengthy strand of ribbon. No curling is involved. No need to address the problem of jamming which would require a stripping means.

There is no motivation to combine this invention with any of the patents listed herein together with curling inventions, in effect combining three different patents from three different fields. The only remote relevance here is the presence of conveyor belts. This is of no import since the instant application does not claim to invent conveyor belts, simply the novel invention of their use as a stripping means to allow a curling machine to function on a mass production basis. Sorting newspaper bundles is not relevant in either function, means or result.

4. 2,633,930 Staege

This is a paper making machine. No curling is involved. There is a train of several conveyors and the use of air. The air however is not to prevent jamming by directing the web away from the drive means but rather the air directs the web of paper towards the conveyor belts so that they cause the lead strip to engage the belt or follow particular belts. The air is not a stripping means but merely a directive guide for the paper to follow a particular path of engagement and disengagement with the belts. It is the anti-thesis of stripping means.

5. 1,595,478 Minton

This is an invention which primarily is to dry wet webs of paper. It describes a scrapper and use of a jet of fluid to strip the wet web off the drying cylinders. The problem to be solved by the inventor dictates the prior art that a skilled man in the art would look to. He would not look to this field of art to solve a ribbon curling problem. The problem in the paper manufacture field is the use of scrappers or "doctors" wear out quickly, they wear out the cylinders upon which they press, they can damage the paper. Because the doctors need to press against the cylinders to direct the paper off of it, this pressure is disadvantageous. The inventor here sought to have a more benign means of removing the paper from the drying cylinders. The issue was not one of preventing the movement of the web material back upstream towards the drive means which could cause jamming. This feature is a distinct claim limitation of the Goldstein patents in suit. Combining elements of this patent with a curling machine to claim obviousness would involve hindsight which is impermissible. Although one can argue ribbon and paper are both web material, the commonality is not such that a skilled man in the art would look to both fields and combine non-analogous inventions.

6. 287,957 Osborne

This patent is from 1883. It involves using a charge of electricity to have the web adhere to the cylinder. An opposing charge releases it. The "stripper" is actually upstream of the drive means, not downstream as in the Goldstein patents, and does not perform the claim limitation of preventing jamming of the drive means- it simply acts to disengage the web from the drive means. The solution it addresses is entirely different from the instant invention.

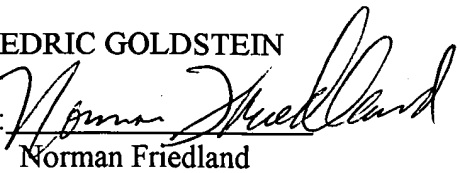
Applicant believes that a record of this decision should prudently be made a part of this application file wrapper as it relates to the family of patents regarding this invention which share

the same specification.

This will authorize the payment of the statutory fee to be charged to Deposit Account No. 062000 Order No. N898.

Respectfully submitted,

FREDRIC GOLDSTEIN

By: 

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